

REMARKS

In the final Office Action, claims 1-19 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. As set forth below, claims 1, 3, 4, and 11 have been amended to expedite prosecution. In addition, claim 5 has been canceled and claims 26-31 have been added. Thus, claims 1-4, 6-19 and 26-31 are currently pending in the case. Further examination and reconsideration of the application are therefore respectfully requested.

Section 112 Rejections

Statements in the Office Action reject claims 1-19 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. *Ex Parte Porter*, 25 USPQ2d 1144, 1145 (Bd. Pat. App. & Inter. 1992) MPEP 2173.05(e). As will be set forth in more detail below, the § 112, second paragraph, rejection of claims 1, 3, 4, 13 and 17-19 is respectfully traversed. Claims 2, 6-12, and 14-16 are not specifically cited against in the Office Action; thus, Applicants assume that those claims are rejected merely for being dependent on a rejected base claim.

On page 2 of the Advisory Action, the Examiner states, "[c]laims 1 and 13 are genus claims attempting to claim the three embodiments in a single independent claim ... However, they are detailed enough that they do not accurately claim the three embodiments." The Examiner also suggests that "[i]n the independent claims it is not clear where the editor is located." (Advisory Action, page 2). Claims 1, 3, and 4 have been amended to expedite prosecution. In particular, claim 1 has been amended to limit the scope of the claim by reciting the embodiment in which the editor operates within the client. Claims 3 and 4 have each been rewritten in independent form to recite the embodiments in which the editor operates within the web server and ad server, respectfully. Support for the amendments to claims 1, 3, and 4 may be found in the claims themselves, as well as in the specification on page 5, line 10 - page 6, line 16, and on page 14, line 25 - page 18, line 2. These amendments are believed to clarify the claim language in a manner that addresses the concerns about those claims expressed in the Advisory Action. For at least these reasons, Applicants respectfully request that this rejection as to claims 1, 3, and 4, as well as all claims dependent therefrom, be removed.

Though the Applicants chose to make amendments to system claim 1, the Applicants maintain their previous arguments concerning method claim 13. For at least the reasons set forth in more detail below, Applicants assert that the § 112 rejection of claim 13, and all dependents therefrom, is improper and that no amendments are necessary to clarify the present claim language.

With regard to claim 13, the Examiner suggests that "[i]t is unclear where the overlaying is performed." (Office Action, page 3, emphasis added). The Examiner further suggests that the broadly claimed editor (or process of overlaying) renders claim 13 indefinite (Office Action, page 3). Applicants respectfully disagree. More specifically, Applicants are unaware of any basis in which the particular structure requested in the Office Action (i.e., the location where the overlaying is performed) must be added to claim 13. In fact, MPEP 2173.05(b) makes clear that "process or method claims are not subject to rejection by U.S. Patent & Trademark Office Examiners under 35 U.S.C. 112, second paragraph, solely on the grounds that they define the inherent function of a disclosed machine or apparatus."

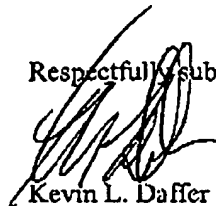
The method of claim 13 discloses a process of overlaying a portion of the first image with a second image obtained from a second computer, coupled to the first computer by a network, to obtain a modified first image. To avoid unduly limiting the scope of the claims, the presently claimed process of overlaying should not be limited to a particular structure or location. In fact, the Specification clearly teaches that "[t]he editor is merely software executable within any execution unit, including the web server, ad server or client, or neither the web server, ad server or client but some execution unit altogether separate from the web server, ad server or client." (Specification, page 6, lines 13-16, emphasis added). Applicants wish to remind the Examiner that claim 13 is a method claim, and therefore, is not required to define the structure (i.e., the editor) responsible for performing the process of overlaying. Consequently, Applicants respectfully request that this rejection of claim 13, and all claims dependent therefrom, be removed.

CONCLUSION

This response constitutes a complete response to all issues raised in the Advisory Action mailed March 16, 2004. In view of the remarks traversing the rejections presented, Applicants assert that pending claims 1-4, 6-19, and 26-31 are in condition for allowance. If the Examiner has any questions, comments, or suggestions, the undersigned attorney earnestly requests a telephone conference.

No fees are required for filing this amendment; however, the Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment, to Conley Rose, P.C. Deposit Account No. 03-2769/5468-05800.

Respectfully submitted,



Kevin L. Daffer
Reg. No. 34,146
Attorney for Applicant(s)

Conley, Rose, P.C.
P.O. Box 684908
Austin, TX 78768-4908
Ph: (512) 476-1400
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JMF